

Amendments to the Abstract

Please replace the Abstract on page 48 with the following amended Abstract. A separate replacement sheet containing the Abstract as amended is enclosed herewith.

~~The present invention relates to~~ A biomass resin composition ~~comprising~~ comprises a phenolized biomass substance and a reactive substance having a melting point of at most 100°C other than phenol and selected from the group consisting of butylphenol, octylphenol, nonylphenol, benzylphenol and benzyl phenyl ether. The biomass resin composition is prepared by a process, which comprises adding a reactive substance such as a phenol derivative or drying oil into the reaction system, in the step of preparing a phenolized biomass substance by phenolizing a biomass substance with a phenol in the presence of an acid catalyst. The ~~present invention provides a biomass resin composition, in which the melting point of~~ the biomass resin composition can be freely controlled and ~~which the composition~~ is excellent in properties such as flowability, processability, water resistance and impact resistance and can be prepared by a simple process, ~~and a process for preparing the same.~~

REMARKS

By the above amendments the Abstract has been amended, claims 3 and 4 have been cancelled and claims 1, 10 and 13 have been amended. Thus, claims 1, 2 and 5-17 are in the application. Claims 5-7, 11 and 14-17 stand withdrawn from consideration as being directed to a non-elected invention and species.

Claims 10, 12 and 13 were objected to in the Office Action under 37 C.F.R. §1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. Responsive to this objection, by the above amendments, claim 10 has been amended to place the claim in independent form. It is respectfully submitted that claims 10, 12 and 13 as amended are proper under 37 C.F.R. §1.75(c).

Claims 1, 2, 8-10 and 12 are provisionally rejected in the Office Action on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending application no. 10/898,477, (Shimo, et al. U.S. 2005/0020794) as stated on pages 3 and 4 of the Office Action. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Responsive to this provisional rejection, Applicants respectfully note that the present application was filed March 24, 2004, and claims priority based upon Japanese Application No. JP2003/128293 filed May 6, 2003. Thus, the present application has an earlier filing date in the United States and an earlier priority date under 35 U.S.C. §119, the claim for which was perfected in the present application by the filing of a certified copy of the Japanese application on August 30, 2004. The Shimo, et al. published application is not prior art against the present application under 35 U.S.C.

§102(e). Further, pursuant to MPEP 804, it is requested that the Examiner withdraw the rejection and permit the present application, the earlier-filed application, to issue as a patent without a Terminal Disclaimer.

Claims 1-4, 8-10, 12 and 13 were rejected in the Office Action under 35 U.S.C. §112, first paragraph, as allegedly not reasonably providing enablement for the breadth of the claims as being "reactive compounds". Responsive to this rejection, by the above amendments the independent application claims, claims 1 and 10, have been amended to positively recite that the reactive substance is selected from the group consisting of butylphenol, octylphenol, nonylphenol, benzylphenol and benzyl phenyl ether as previously recited in dependent claim 4 which was cancelled by the above amendments. In view of the amendments, it was respectfully submitted that the claims are proper under 35 U.S.C. §112, first paragraph.

Claims 10, 12 and 13 were rejected on page 5 of the Office Action under 35 U.S.C. §112, second paragraph, as being indefinite because allegedly there was no antecedent basis in claim 1 to support the recitation in claim 7 of "or a precursor thereof". Responsive to this rejection, as noted above, claim 10 has been rewritten in independent form so as to positively recite the process for preparing a biomass resin composition. In view of the amendments, it is respectfully submitted that claims 10, 12 and 13 are proper under 35 U.S.C. §112, second paragraph.

Claims 1, 2, 8-10 and 12 were rejected in the Office Action under 35 U.S.C. §102(e) as being anticipated by Shimo et al. (US 2005/0020794) as stated on page 6 of the Office Action. As noted above, Shimo, et al. is not prior art under 35 U.S.C. §102(e) with respect to the present invention

because of the respective filing date of the present application and Shimo, et al. as noted above.

Claims 1, 3, 8 and 9 were rejected in the Office Action under 35 U.S.C. §102(b) as being clearly anticipated by Kunio, et al. (JP 05-140465) as stated on page 6 of the Office Action.

Claims 1, 2, 8-10, 12 and 13 stand rejected under 35 U.S.C. §102(b) as allegedly being clearly anticipated by Rachor, et al. (US 3,912,706), see pages 6 and 7 of the Office Action.

Claims 1, 2, 8, 10, 12 and 13 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Funabiki, et al. (US 4,058,403), as stated on page 7 of the Office Action.

Claims 1, 2, 9, 10 and 13 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by Calve, et al. (US 4,579,892), as stated on page 7 of the Office Action.

Claims 1, 2, 8-10, 12 and 13 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Tsujimoto, et al. (US 5,110,915), as stated on page 7 of the Office Action.

Claims 1-4, 8-10, 12 and 13 were rejected in the Office Action under 35 U.S.C. §103(a) as being unpatentable over Kunio, et al. in view of Novotny, et al. (US 2,300,307, not 5,110,915 as mistakenly indicated on page 8 of the Office Action). The references were cited for the reasons and in the manner set forth on page 8 of the Office Action.

These rejections are hereby traversed and reconsideration thereof is respectfully requested in view of the above amendments to the claims and Applicants' remarks as set forth below.

Concerning the cited reference to Kunio, et al. Applicants note that Kunio, et al. discloses composition obtained by kneading under heat phenol with novolac-wood flower resin prepared by reacting wood flower with a phenol. However, the present invention is different from Kunio, et al. since Kunio, et al. does not disclose the specific phenol derivatives described in the present invention as recited in the application claims as amended.

In addition, the present invention is also different from Rachor, et al., Funabiki, et al., Calve, et al., and Tsujimoto, et al., since these references do not disclose the specific reactive substance such as the phenol derivatives described in the present invention as recited in the claims as amended. Thus, it is respectfully submitted that Applicants' claims as amended are not anticipated by under 35 U.S.C. §102 by the cited references.

Concerning the rejection of the application claims under 35 U.S.C. §103 over Kunio, et al. in view of Novotny, et al., Applicants respectfully note that Novotny, et al. discloses only at least one phenolic compound, and Novotny, et al. does not describe a melting point of at most 100°C and the specific phenol derivatives described in the claims as amended.

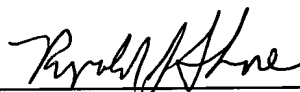
Further, Applicants respectfully note that, in general, the phenolic compound contains phenol. But the present specification discloses that phenol is unfavorable as the reactive substance in the composition of the present invention. On the other hand, the specific phenol derivatives disclosed and claimed are preferable from the view point that the effects of lowering the melting point and improving moldability of the biomass resin composition are large, and these effects are more excellent than phenol. See page 13, lines 15-18 in the specification, for example. Therefore, Applicants

respectfully submit that the present invention in which the specific phenol derivatives as the reactive substance are used is not obvious, 35 U.S.C. §103, over Kunio in view of Novotny, et al.

In view of the above amendments are remarks, reconsideration of the application claims as amended is requested. It is respectfully submitted that the claims as amended are now in condition for allowance and such action by the Examiner is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 512.43705X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



Ronald J. Shore
Registration No. 28,577
ANTONELLI, TERRY, STOUT & KRAUS, LLP

RJS/kmh

Attachments